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EXAMINER

BURGESS, BARBARA N

ART UNIT PAPER NUMBER

2157

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,288

Applicant(s)

SUILA ET AL.

Examiner

Barbara N. Burgess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 56-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 56-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 6-22-06
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to amendments filed March 31, 2006. Claims 1-27 and 56-75 are presented for further examination.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 10-11, 13-15, 17-24, 26-27, 56-57, 59, 60-62, 64-66, 68-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durst, Jr. et al. (hereinafter "Durst", 6,542,933 B1) in view of Sussman (US Patent Publication 2002/0161658 A1).

As per claims 1 and 56, Durst discloses a system and method for providing information concerning a consumer item to a user comprising:

- An object of interest (OI) identification information (OI-Id) provider, wherein the OI is a consumer item and said OI-Id provider is in a specific location (column 1, lines 32-35, column 5, lines 10-20);
- A portable shopping assistant (PSA) for receiving the OI-Id in the specific location and for transmitting the received OI-Id (column 1, lines 30-35, column 3, lines 25-30, column 5, lines 10-20, 39-42, 65-67, column 6, lines 1-2);
- An information server system (ISS) for receiving the OI-Id transmitted by said PSA, for matching the received OI-Id with a record containing consumer item

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information (P/S Info)-corresponding to the received OI-Id, for determining a communication method, and for transmitting the P/S--Info using the determined communication method (column 3, lines 1-15, 35-40, 65-67, column 4, lines 1-5, column 6, lines 11-22, 29-45);

- An output device for receiving P/S-Info from said ISS and outputting the P/S-Info to the user (column 3, lines 65-67, column 4, lines 1-7, column 6, lines 10-28);
- Wherein the specific location is one of a location where the OI is present, a location having material associated with the OI, and a location where an event associated with the OI is taking place (column 1, lines 32-35, column 7, lines 51-60).

Durst does not explicitly disclose:

- Said output device being separate from the PSA.

However, in an analogous art, Sussman discloses the bar scanner transmits the scanned UPC to the base station. The base station connects via the Internet to the UPC database to obtain further information and description of the UPC. The information is downloaded to the consumer's Internet Appliance, PDA, PC, or cell phone...whichever the consumer is most comfortable with (paragraph [0032]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Sussman's outputting P/S Info to the user in an output device separate from the PSA in order for the user to share her various shopping lists on multiple devices.

As per claims 2 and 57, Durst discloses the system and method of claims 1 and 56, wherein, in the location where an event associated with the OI is taking place,

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the associated event comprises one of a concert, a lecture, and a sports event (column 1, lines 32-35, column 7, lines 51-60).

As per claim 3, Durst discloses the system of claim 1, wherein the PSA comprises one of a cellular telephone, a personal digital assistant (PDA), a laptop computer, and a dedicated device (column 1, lines 27-35, column 3, lines 25-30, column 5, lines 35-42).

As per claim 4, Durst further discloses the system of claim 1, wherein the PSA receives OI-Id by one of radiofrequency (RF) communication, infrared JR) communication, sonic communication, label scanning and manual entry (column 1, lines 27-35, column 3, lines 25-30, column 5, lines 35-42).

As per claim 5, Durst discloses the system of claim 1, wherein the OI-Id comprises a consumer item identification code (column 1, lines 23-30, column 3, lines 25-27, column 5, lines 10-20).

As per claim 6, Durst discloses the system of claim 1, wherein the PSA receives the OI-Id by short-range, low power radiofrequency (RF) technology (column 1, lines 27-35, column 3, lines 25-30, column 5, lines 35-42).

As per claims 7, 11, 15, 62, 66, Durst does not explicitly discloses the system and method of claims 6, 10, 13, 58, 64, wherein the short-range, low power RF technology

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comprises one of Bluetooth technology, IEEE 802.16 technology, and HiperLAN technology.

However, the use and advantages of using Bluetooth is well known to one skilled in the relevant art at the time the invention was made as evidenced by Sussman (paragraphs [0039]-[0041]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Bluetooth in Durst's system in order for the scanner to automatically see if a registered base station is within 30 feet of it.

As per claims 10, 13, 17, 60, 64, 68, Durst discloses the system and method of claims 1, 13, 56, 64, wherein the PSA transmits the 01-Id by one of the Internet, a wired telephone network, a short-range, low power radio-frequency (RF) technology, a wireless local area network (*WLAN*), and a cellular telephone network (column 1, lines 27-35, column 3, lines 25-30, column 5, lines 35-42).

As per claims 14, 61, 65, Durst does not explicitly discloses the system and method of claims 13, 58, 64, wherein the broadcast network comprises one of a digital audio broadcast (DAB) system, a digital video broadcast (DVB) system, a satellite system, a microwave broadcast system, and a cable television system.

However, the use and advantages of using one of a digital audio broadcast (DAB) system, a digital video broadcast (DVB) system, a satellite system, a microwave broadcast system, and a cable television system is well known to one skilled in the

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relevant art at the time the invention was made as evidenced by Sussman (paragraphs [0028], [0030], [0039]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate using one of a digital audio broadcast (DAB) system, a digital video broadcast (DVB) system, a satellite system, a microwave broadcast system, and a cable television system in Durst's system in order to scan home appliances with bar codes.

As per claims 20-22, 27, 59, 71-75, Durst discloses the system and method of claims 1, 20, 56, 71, wherein the ISS comprises:

- An OI-Id server for receiving the OI-Id, resolving a correct destination address for a P/S Info server which has the record containing the P/S-Info corresponding to the received OI-Id, and transmitting a request for P/S-Info to a P/S-Info Server (column 3, lines 1-15, 35-40, 65-67, column 4, lines 1-5, column 6, lines 11-22, 29-45);
- Said P/S-Info server for receiving the request for P/S-Info, for finding the record containing the P/S-Info, and for transmitting the P/S-Info (column 3, lines 1-15, 35-40, 65-67, column 4, lines 1-5, column 6, lines 11-22, 29-45);
- Means for determining a user identification (UID) of a user of the PSA (column 3, lines 50-64, column 6, lines 23-28, column 7, lines 5-19);
- A user information (UID-Info) server containing UID-Info files sorted by user identification (UID) for matching a UID-Info file with said determined UID, wherein the UID-Info file comprises at least a communication destination address for the user (column 8, lines 1-55, column 10, lines 50-67, column 11, lines 1-25);

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- Means for transmitting said P/S-Info to the communication destination address in the matching UID-Info file (column 8, lines 1-55, column 10, lines 50-67, column 11, lines 1-25).

As per claim 23, Durst discloses the system of claim 22, further comprising:

- A public switched telephone network (PSTN) comprising the 01-Id server, the UID-Info server, and the means for determining a UID (column 8, lines 1-55, column 10, lines 50-67, column 11, lines 1-25);
- Wherein the means for transmitting the P/S-Info comprises the Internet (column 3, lines 1-15, 35-40, 65-67, column 4, lines 1-5, column 6, lines 11-22, 29-45).

As per claim 24, Durst discloses the system of claim 23, wherein the PIS-Info server is on the Internet and the P/S Info request and response is transmitted over the Internet (column 3, lines 1-25).

As per claim 26, Durst does not explicitly discloses the system of claim 1, further comprising:

- A Bluetooth chip comprising the 01-Id provider;
- At least one broadcasting provider connected to the network for transmitting the P/S-Info, said at least one broadcasting provider comprising at least one of a digital audio broadcast (DAB) system, a digital video broadcast (DVB) system, a satellite system, a microwave broadcast system, and a cable television system.

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However, the use and advantages of using Bluetooth is well known to one skilled in the relevant art at the time the invention was made as evidenced by Sussman (paragraphs [0039]-[0041]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Bluetooth in Durst's system in order for the scanner to automatically see if a registered base station is within 30 feet of it.

3. Claims 8-9, 12, 16, 25, 58, 63, 67, are rejected under 35 U.S.C. 103(a) as being unpatentable over Durst, Jr. et al. (hereinafter "Durst", 6,542,933 B1) in view of Sussman and in further view of Gottsman et al. (hereinafter "Gottsman", 6,134,548).

As per claims 8, 12, 16, 63, 67, Durst, in view of Sussman, does not explicitly disclose the system and method of claims 1, 10, 13, 58, 64, wherein the PSA is a cellular telephone, further comprising: a cellular telephone network for receiving the 01-Id transmitted by said cellular telephone and for transmitting the 01-Id to the ISS. However, the use and advantages of using a cellular telephone as the PSA is well known to one skilled in the relevant art at the time the invention was made as evidenced by Gottsman (abstract, column 31, lines 17-20).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate a cellular telephone in Durst's system in order to obtain definitive product identification by scanning a bar code.

As per claim 9, Durst, in view of Sussman, does not explicitly disclose the system of claim 1, wherein the PSA is a cellular telephone, said cellular telephone being

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registered to receive services of the consumer item information system by having appropriate information entered in a file of a subscriber database maintained by a cellular telephone system.

However, the use and advantages of using a registering the cellular telephone in a subscriber database is well known to one skilled in the relevant art at the time the invention was made as evidenced by Gottsman (abstract, column 31, lines 17-20, column 33, lines 15-36, column 34, lines 28-67).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate registering a cellular telephone in Durst's system in order to have information about the user.

As per claims 25, 58, Durst, in view of Sussman, does not explicitly disclose the system and method of claims 1, 56, further comprising:

- A cellular telephone comprising the PSA (column 31, lines 17-20, column 33, lines 15-36, column 34, lines 28-67);
- A short message service (SMS) system connected to a cellular telephone system and to the Internet, said cellular telephone being in a transmission area of said cellular telephone system, said SMS system for receiving the OI-Id, resolving a destination Internet Protocol (IP) address for a P/S-Info server which has the record containing the P/S Info corresponding to the received OI-Id, resolving a destination IP address for the output device, and transmitting a request for P/S-Info containing the destination EP address of the output device over the Internet to the P/S-Info server;

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- Said P/S-Info server connected to the Internet for receiving said request for P/S-Info, for finding the record containing the P/S-Info, and for transmitting the P/S-Info to the output device (column 31, lines 17-20, column 33, lines 15-36, column 34, lines 28-67).

However, the use and advantages of using a cellular telephone as the PSA is well known to one skilled in the relevant art at the time the invention was made as evidenced by Gottsman (abstract, column 31, lines 17-20).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate a cellular telephone in Durst's system in order to obtain definitive product identification by scanning a bar code.

Response to Arguments

4. Applicant's arguments filed have been fully considered but they are not persuasive.

The Office notes the following arguments:

- (a) There is no mention of a server that determines a communication method and transmits P/S-info using the determined communication method in Durst.
- (b) Such a determination means that server selects from multiple different communication protocols, such as the Internet, a wired telephone network, a broadcast network, a short-range, low power radio-frequency (RF) technology, a wireless local area network (WLAN), and a cellular telephone network to transmit P/S-Info.
- (c) Sussman fails to teach that a server determines a communication method from multiple communication methods for use in sending P/S-Info.

In response to:

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(a) Durst discloses the information server sending the requested product information to the requesting client device (column 3, lines 17-25, column 6, lines 11-15, 20-22).

The client may be any type of computing device capable of accessing the network such as a personal computer connected to the Internet. The client may also be a web-enabled cell phone, PDA, etc. As well, communication between the information server and the client device may be implemented over different types of distributed computing networks such as Internet, intranet, a wireless network, and various combinations thereof (column 5, lines 23-42).

According to Applicant's disclosure, a PDA (PSA) is used to request information from the information server (ISS) and the information server (ISS) returning the requested information to the PDA via radiofrequency (RF) transmission (page 14-15, paragraph [0026]). Again, Durst discloses the client device (PSA) being a PDA and the information server (ISS) utilizing the appropriate communication to return requested information (column 5, lines 36-38, column 6, lines 11-15).

Therefore, Durst, undoubtedly, discloses "a server that determines a communication method and transmits P/S-info using the determined communication method".

(b) Durst further discloses the information server and client device interconnected for selective communication with each other as required by the system. Communication could be implemented by Internet, intranet, wireless network, and various combinations thereof (column 5, lines 23-32).

Applicant states, "Determination means that server selects from multiple different communication protocols". This limitation is not found in the claim language. However,

Durst explicitly discloses selecting communication that is required for the device involved in communication with each other.

(c) Applicant admits the Sussman teaches a single pre-selected standard is used for communication between devices, such as PDA, and the scanner, i.e. Bluetooth (response dated March 31, 2006, page 24).

However, Applicant argues that Sussman fails to teach that a server determines a communication method from multiple communication methods for use in sending P/S-Info. In response to applicant's argument that the reference fails to show this feature of applicant's invention, it is noted that the feature upon which applicant relies (i.e., a server determines a communication method from multiple communication methods for use in sending P/S-Info) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N. Burgess whose telephone number is (571) 272-3996. The examiner can normally be reached on M-F (8:00am-4:00pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara N Burgess
Examiner
Art Unit 2157

June 22, 2006


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